

requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Sweet fail to disclose all of the elements of the claims of the present invention, particularly, the image and text nodes and audible output, as discussed above, but also, if combined with Nishizawa and Cohen, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Sweet, alone or in combination with Nishizawa and Cohen teaches a method and system containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

In view of the foregoing, the Applicants respectfully submit that the cited prior art

references, Sweet, Nishizawa, and Cohen are not legally combinable, and even if they were, they still do not teach or suggest the features defined by amended independent claims 1, 14, and 24 and as such, claims 1, 14, and 24 are patentable over Sweet alone or in combination with Nishizawa and Cohen. Further, dependent claims 2-6, 8-13, 15-18, and 20-23 are similarly patentable over Sweet alone or in combination with Nishizawa and Cohen, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

IV. Formal Matters and Conclusion

With respect to the objections/rejections to the specification/claims, the specification and claims have been amended, above, to overcome these rejections. Therefore, the Examiner is respectfully requested to reconsider and withdraw the objections/rejections to the specification/claims.

In view of the foregoing, Applicants submit that claims 1-6, 8-18, and 20-24, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any

overpayments to Attorney's Deposit Account Number 50-0510.

Respectfully submitted,

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